

REQUEST FOR REHEARING	Application #	08/981,665
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	Filing Date	11/05/1997
	First Inventor	CIPKOWSKI
	Art Unit	1641
	Examiner	Grun, James Leslie
	Docket #	P08948US01/BAS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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FROM THE DECISION MAILED FEBRUARY 2, 2012

BRIEF IN SUPPORT OF REQUEST FOR REHEARING/RECONSIDERATION

A. INTRODUCTION

In the Decision on Appeal, the Board of Patent Appeals and Interferences ("Board") reversed the rejection of Claims 16, 18 and 19 under 35 U.S.C. §112, and this reversal is acknowledged with appreciation. On the other hand, the Board upheld the Examiner's rejection under 35 U.S.C. §103(a) as unpatentable over May et al. PCT application WO 88/08534 ("May") in view of Sun et al. US 5,238,652 ("Sun") and further in view of Boger et al. US 4,518,565 ("Boger"). However, since the Board's decision was based on a misapprehension of the relevant references, Applicant/Appellant requests a rehearing pursuant to 37 CFR §41.52 and MPEP 1214.03 and/or a reversal of the Examiner's rejection under 35 U.S.C. §103.

B. THE BOARD'S DECISION INCORRECTLY STATES THAT MAY TEACHES DIRECTLY CONTACTING THE FRONT SURFACE OF THE TEST STRIP, AND THIS MISAPPREHENSION OF THE TEACHING WAS THE BASIS OF THE DECISION TO UPHOLD THE EXAMINER'S REJECTION UNDER 35 U.S.C. § 103(A)

As Appellant has previously pointed out, the primary reference cited in the Section 103 rejection, namely the May reference, discloses a device which is fundamentally different than Appellant's claimed invention. In particular, the claimed invention is a substantial improvement over the prior art because it provides a test card that is configured so that a sample may be applied to the front of the test strip which may then proceed via capillary action along the strip to the test portion wherein an analyte in the specimen may be visually determined through another opening in the test card. This is a significant difference from May reference wherein the sample is not only

directed away from the front surface of the test strip, the opening over the front surface of the test strip is covered up to **prevent** the sample from contacting the test strip on the front surface of the strip.

In addressing this issue, the Board acknowledged that the Appellant's claims were not shown in May, but stated that:

"...May specifically teaches that the dry porous carrier that makes up the test strip may communicate with the exterior of the casing either directly or indirectly . . . so that the test sample may be applied" Decision of Appeal, page 11, referring to FF11 (May at page 3).

This passage was cited in an effort to show that it would have been within the level of skill of the ordinary artisan to apply the sample directly onto the front surface of the test strip, emphasizing the "*directly or indirectly*" language from FF11. However, the Board's reliance on the passage of page 3 is misplaced since in each and every case, including the embodiment of Figs. 11-12, the front surface is **prevented** from contacting the test sample directly, and the only embodiment wherein the sample may contact the test strip directly is shown in Figs. 13 and 14 (as described on pages 28-29 of May) wherein the test strip 705 extends the length of the casing so that the **end** (and **not** the front surface) can directly be contacted with the sample. Once again, in this embodiment, the skilled artisan is **taught away** from a test card configuration wherein the sample contacts the test strip directly on the front surface.

Indeed, in the embodiment cited by the Examiner, the device in May is specifically configured to **avoid** having the test strip contacted directly on its front surface by the sample. This is shown in Figs. 11-12 and described on page 27 wherein the test strip 606 is located inside of casing 600 which has apertures 603 and 604

directly above its front surface. However, these apertures are covered by a transparent backing sheet 607 which **prevents** the sample from passing through apertures 603 and 604 onto the front surface of the test strip. The description confirms this as follows:

“A test strip of similar construction to that described with reference to Embodiment 4, comprising a porous strip 606 backed by a transparent plastics sheet 607 is also connected with casing 600, and extends from the porous receiving member 602, with which the porous carrier is in liquid permeable contact, to the extreme other end of the casing. The transparent backing sheet 607 is in firm contact with the upper inner surface 608 of casing 600, and *provides a seal against apertures 603 and 604 to prevent ingress of moisture or sample into the casing.*” May at page 27, bottom paragraph (emphasis added).

Accordingly, the uniform and consistent teaching in May is **contrary** to the functioning of Appellant's test card, namely it **prevents** the sample from contacting the test strip on its front surface, and thus May **teaches away** from the present claims. Appellant's claimed invention is a non-obvious improvement over the configuration in May because it avoid the problems associate with May, namely the blocking of the sample that must proceed up the test strip for the analyte determination, and the much slower wicking along the test strip using the May device. The present invention overcomes these problems and provides a more rapid and more accurate analysis of the sample because it allows more of the sample to proceed up the test strip at a faster rate.

In short, the May reference cited by the Examiner and relied upon by the Board discloses a device that is fundamentally different than Appellant's claimed invention, and one which teaches away from Appellant's claimed invention because it prevents the user from obtaining the results obtained using Applicant's claimed test card.


In light of the fact that the decision of the Board was based on a misapprehension of the primary reference upon which the rejection for obviousness under 35 U.S.C. §103(a) was based, Appellant respectfully requests a rehearing and/or a reconsideration of the Board's decision wherein the Examiner's rejection under 35 U.S.C. §103(a) is reversed.

C. CONCLUSION

For the reasons as stated above, Appellant requests rehearing and reconsideration of the Board's decision dated February 2, 2012 and/or a reversal of the Examiner's rejection under 35 U.S.C. §103.

Respectfully submitted,

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